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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/715,641
Filing Date: November 17, 2000
Appellant(s): HASKINS ET AL.

David W. Rouille, Reg. No. 40,150
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 February 2006 appealing from the
Office action mailed 27 May 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello et al. (U.S. Patent Number 6,381,634) in view of Janacek et al. (U.S. Patent Number 6,684,248).

1. Regarding claims 1, 2, 12-14, 15, and 26-28, Tello disclosed a system and method for controlling transmission of messages from an originator computer system, comprising:

a processor, memory system, and network interface (Tello, col. 3, line 60 through col. 4, line 5, The invention can be implemented with different computers, such as personal computers, UNIX based workstations, or devoted servers, having a communications protocol for Internet communication);

detecting an outbound message from an originator computer system (Tello, col. 6, lines 9-17, Tello disclosed the SCP counting the number of messages being sent by users);

verifying an authenticity of an originator address associated with the outbound message (Tello, col. 5, lines 45-65, Tello disclosed password protected accounts for users to use their unique email addresses, meaning that users are verified before using their email address, therefore the originator address of every message sent out is verified);

performing a quota enforcement operation based on a message count and a message limit to produce a message transmission result (Tello, col. 6, lines 9-17, Tello disclosed the SCP server detecting outbound messages from subscribed users, and performing a quota enforcement operation by comparing the number of messages sent by a user with a global threshold limit); and

performing a selective transmit operation including at least one of

i) transmitting the outbound message onto a computer network if the message transmission result contains a transmit value; and

ii) preventing transmission of the outbound message onto a computer network if the message transmission result contains a no transmit value (Tello, col. 6, lines 9-17, Tello disclosed if a user submits one-thousand messages, then the global threshold limit is exceeded and the email messages do not get transmitted, otherwise they do get transmitted);

in order to determine a message transmission result that indicates if the originator computer system operating to transmit the outbound electronic mail message using the originator identity is attempting to transmit the outbound electronic mail message to a number of recipients that exceeds the message limit, and if the message transmission result is a no-transmit value, preventing transmission of outbound electronic mail messages onto the computer network for the originator identity, and if the message transmission result is a transmit value, allowing transmission of the outbound electronic mail message onto the computer network on behalf of the originator identity. (Tello, col. 5, lines 45-65, col. 6, lines 9-20, Tello discloses the SCP server detecting outbound messages from **subscribed users**, and performing a quota enforcement operation by comparing the number of messages sent by a user with a global threshold limit. If the message count exceeds the threshold limit, the messages do not get transmitted, and an error message is returned).

However, Tello did not explicitly state when the result is a transmit value, updating a message count associated with the originator identity of the outbound message.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that keeping track of the number of messages and comparing against a global threshold limit would require updating a message count associated with the originator identity of the outbound message, in order to keep track of the number of messages sent by one user, for the benefit of preventing spamming of unsolicited messages (Tello, col. 6, lines 1-17).

In an analogous art, Janacek disclosed a method of transferring data from a sender to a recipient including a server that contains a database that keeps track of user statistics, including a message count which tracks the total number of messages sent by the user (Janacek, col. 10, lines 55-67, col. 12, lines 1-5). Janacek also disclosed users having unique email addresses, that require user authentication in order to send and receive email with their unique email address (Janacek, col. 3, lines 50-67). Both Tello and Janacek include monitoring of subscriber usage of email systems. Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate the user database of Janacek into Tello for the benefit of providing controlled message distribution (Janacek, col. 2, lines 50-55) while keeping secure message delivery as technically unchallenging as possible but still providing uncompromising data protection (col. 3, lines 30-35).

Claims 2, 12-14, 15, and 26-28 include limitations, substantially similar to claim 1, and are therefore rejected under the same rationale. Regarding claim 13, Tello and Janacek did not explicitly state including multiple message counts and message limits. Applicant is reminded that adding/duplicating parts for multiple effect does not make an invention patentable, see duplicating parts for a multiple effect *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8 (7th Cir. 1977). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have a plurality of message counts and thresholds in order to properly carry out the function of preventing users from spamming (Tello, col. 6, lines 1-9).

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2. Regarding claim 3, Tello and Janacek disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein the step of comparing the message count associated with an originator identity of the outbound message includes the steps of.

obtaining an originator address associated with the outbound message (Tello, col. 5, lines 55-67);

obtaining the originator identity associated with the outbound message by performing an originator identity lookup based on the originator address (Tello, col. 5, lines 55-67); and

obtaining at least one message count associated with the originator identity by performing a message count lookup based on the originator identity (Janacek, col. 10, lines 55-67, col. 12, lines 1-5). See above for motivation.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello et al. (U.S. Patent Number 6,381,634) in view of Barchi (U.S. Patent Number 6,507,866).

3. Regarding claims 1-6 12, 14-17, and 26-28, Tello disclosed a system and method for controlling transmission of messages from an originator computer system, comprising:

a processor, memory system, and network interface (Tello, col. 3, line 60 through col. 4, line 5);

detecting an outbound message from an originator computer system;

verifying an authenticity of an originator address associated with the outbound message;

performing a quota enforcement operation based on a message count and a message limit to produce a message transmission result; and

performing a selective transmit operation including at least one of

i) transmitting the outbound message onto a computer network if the message transmission result contains a transmit value; and

ii) preventing transmission of the outbound message onto a computer network if the message transmission result contains a no transmit value;

in order to determine a message transmission result that indicates if the originator computer system operating to transmit the outbound electronic mail message using the originator identity is attempting to transmit the outbound electronic mail message to a number of recipients that exceeds the message limit, and if the message transmission result is a no-transmit value, preventing transmission of outbound electronic mail messages onto the computer network for the originator identity, and if the message transmission result is a transmit value, allowing transmission of the outbound electronic mail message onto the computer network on behalf of the originator identity. (Tello, col. 5, lines 45-65, col. 6, lines 9-20, Tello discloses the SCP server detecting outbound messages from **subscribed users**, and performing a quota enforcement operation by comparing the number of messages sent by a user with a global threshold limit. If the message count exceeds the threshold limit, the messages do not get transmitted, and an error message is returned. In regards to verifying an

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authenticity of an originator address associated with the outbound message, Tello disclosed password protected accounts for users to use their unique email addresses).

However, Tello did not explicitly state when the result is a transmit value, updating a message count associated with the originator identity of the outbound message. In an analogous art, Barchi discloses an email usage pattern detection system that checks whether the number of email messages from a single originator has exceeded predetermined thresholds (Barchi, col. 7, line 65 through col. 8, line 10). Tello and Barchi both include systems that check for sender side email thresholds for the purpose of keeping track of unwanted messages. Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate Barchi into Tello to provide protection for the receiving email system not only against malicious users, but also against events such as routing accidents (Barchi, col. 5, lines 60-67). See above for motivation.

4. Regarding claims 3 and 16, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein the step of comparing the message count associated with an originator identity of the outbound message includes the steps of.

obtaining an originator address associated with the outbound message (Tello, col. 5, lines 55-67);

obtaining the originator identity associated with the outbound message by performing an originator identity lookup based on the originator address (Tello, col. 5, lines 55-67); and

obtaining at least one message count associated with the originator identity by performing a message count lookup based on the originator identity (Barchi, col. 8, lines 1-8). See above for motivation.

5. Regarding claims 4 and 17, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claim 3, including wherein:

the step of obtaining an originator address includes retrieving a network address associated with the outbound message from a message connection establishment protocol used to transfer the outbound message from an originator computer system to a recipient computer system (Barchi, col. 8, lines 1-8);

the step of obtaining the originator identity includes the step of querying a login database containing mappings of originator addresses to originator identities based on the originator address obtained in the step of obtaining an originator address (Tello, col. 5, lines 55-67, Barchi, col. 8, lines 1-8); and the

step of obtaining a message count for the originator identity associated with the outbound message includes querying a quota database containing associations of message counts to originator identities based on the originator identity associated with the outbound message (col. 8, lines 1-8); and

wherein the message count is at least one message count that indicates, for an originator identity, a current number of outbound message transmitted over an elapsed

time interval (Barchi, col. 7, line 65 through col. 8, line 10); and

wherein the message limit is at least one message limit corresponding to a respective at least one message count that indicates, for an originator identity, a maximum number of outbound messages that may be transmitted over a predetermine time interval (Barchi, col. 7, line 65 through col. 8, line 10). See above for motivation.

6. Regarding claims 5 and 18, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein the step of updating the message count associated with the originator identity of the outbound message includes the steps of calculating a total number of recipients for the outbound message and incrementing the message count associated with the originator identity by the total number of recipients for the outbound message (Barchi, col. 8, lines 1-45, Barchi discloses tracking recipients of email messages). See above for motivation.

7. Regarding claims 6 and 19, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein the message limit indicates an amount of outbound messages that may be transmitted from the originator computer system over a certain period of time for the originator identity associated with the outbound message (Barchi, col. 8, lines 1-10, Barchi discloses a threshold for a period of time); and

wherein the originator identity of the outbound message is indicative of at least one of:

- a specific user account operating under control of a computer user;
- a specific message sending user; and
- a specific domain (Tello, col. 5, lines 59-67, Barchi, col. 7, line 65 through col. 8, line 8).

8. Regarding claims 7 and 20, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein:

- the message limit condition indicates if a computer user account associated with the originator identity used to transmit the outbound message is attempting to transmit a number of outbound messages that exceeds the message limit in a predetermined amount of time (Barchi, col. 7, line 65 through col. 8, line 8); and

- wherein the message limit condition occurs if the step of comparing determines at least one of the message count exceeds the message limit (Barchi, col. 7, line 65 through col. 8, line 8); and

- the message count is equal to the message limit (Barchi, col. 7, line 65 through col. 8, line 8) See above for motivation.

9. Regarding claims 8 and 21, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein the quota enforcement operation includes the steps of:

verifying authenticity of at least one recipient associated with outbound message (Telo, col. 3, lines 50-67, Barchi, col. 8, lines 1-50). See above for motivation.

10. Regarding claims 9 and 22, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 1 and 14, including wherein the step of performing a quota enforcement operation includes the step of:

comparing a previous message transmission result with a no-transmit value, and if the previous message transmission decision equals the no-transmit value, performing the step of performing a selective transmit operation (Barchi, col. 8, lines 1-45). See above for motivation.

11. Regarding claims 10 and 23, Tello and Barchi disclosed the limitation of claims 1 and 14, including wherein the step of detecting an outbound message includes the steps of:

searching a quota enforcement list for an originator address associated with the message, and if the originator address associated with the message is contained in the quota enforcement list, performing the steps of performing a quota enforcement operation and performing a selective transmit operation, and if the originator address associated with the message is not contained in the quota enforcement list, skipping the step of performing the quota enforcement operation and performing the step of transmitting the outbound message from the computer system (Barchi, col. 8, lines 1-45). See above for motivation.

12. Regarding claims 11 and 24, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claim 1, including the steps of:

authenticating a connection from the originator computer system (Tello, col. 5, lines 55-67);

recording authentication information in a login database, the authentication information including an originator address assigned to the originator computer system and an originator identity associated with the originator address (Tello, col. 5, lines 55-67);

receiving, for transmission to a recipient computer system, the outbound message from the originator computer system (Tello, col. 5, lines 55-67, col. 6, lines 1-20);

forwarding the outbound message to a quota server to perform the steps of detecting an outbound message, performing a quota enforcement operation and performing a selective transmit operation (Tello, col. 5, lines 55-67, col. 6, lines 1-20).
See above for motivation.

13. Regarding claim 13, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claim 12, including wherein:

the at least one message count includes a first message count and a second message count (Barchi, col. 8, lines 1-45);

wherein the at least one message limit includes a first message limit and a second message limit (Barchi, col. 8, lines 1-45);

wherein in the step of comparing, the first message count is compared to the first message limit to determine if the first message count exceeds the first message limit in which case the message transmission result is set to a no-transmit value (Barchi, col. 8, lines 1-45); and

wherein in the step of comparing, the second message count is compared to the second message limit to determine if the second message count exceeds the second message limit in which case the message transmission result is set to a no-transmit value (Barchi, col. 8, lines 1-45).

14. Regarding claim 25, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claim 24, including wherein the port redirector is a data communications device capable of directing outbound messages based on content contained within the outbound message, and wherein when the port redirector receives an outbound message that is to be subject to message quota enforcement based upon content contained with the outbound message,, the port redirector forwards the outbound message to the quota server (Tello, col. 5, lines 20-45). See above for motivation.

(10) Response to Argument

The Applicant argues one issue: that neither Tello nor Janacek nor Barchi disclose verification of the authenticity of an originator address associated with an outbound message. This limitation appears in independent claims 1, 14, 26, 27, and 28.

Applicant's argument corresponds to applicant's interpretation as explained as follows.

Applicant alleges that, "Email spoofing refers to email that appears to have been originated from one source when it was actually sent from another source." Applicant then alleges, "The specifying of a fraudulent username as the originator of an email message is known as 'spoofing' an email address, and is done intentionally." Applicant also alleges, "Individuals, who are sending 'junk' email or 'SPAM', typically want the email to appear to be from an email address that may not exist.

Applicant alleges, "Using this technique, the embodiment of the invention can verify the authenticity of the originator address of the outbound message to ensure that the outbound message has arrived from an originator computer system and/or username from which it purports to have arrived."

Applicant also alleges, "By way of the present invention, the verification of the authenticity of an originator address associated with the outbound message prevents spoofing, since only messages with a 'FROM' address that has been verified can be sent."

The Examiner submits that the Applicant's interpretation is inconsistent with the argued claim limitation. The independent claims do not disclose a source, or a username. The claimed invention does not recite any limitations regarding ensuring that the outbound message has arrived from an originator computer system and/or username from which it purports to have arrived. An originator computer system is not the same as an originator address, in terms of email, since a user, sending an email with an originator address, can send the email from any computer system. The term, originator computer system is not recited in the claims. Therefore, Applicant's arguments that refer to sources, usernames, and originator computer systems do not fall within the scope of the claimed invention. Therefore, these arguments are moot.

The argued claim limitation simply refers to an "originator address." Based on Applicant's arguments, a reasonable interpretation is equivalent to a sender's email address. Therefore, what is claimed is, verifying the authenticity of the sender's email address.

The Examiner submits that Janecek disclosed verification of the authenticity of an originator address associated with an outbound message. As the Examiner has cited in the previous office action, Janecek disclosed the invention utilizes traditional e-mail systems (Janecek, col. 4, lines 26-35) in which a user must initiate the account creation process, in which the user creates a unique email address on the system (Janecek, col. 3, lines 47-55) the account being password-protected (Janecek, col. 3, lines 60-65), meaning the user must verify that the unique email system is his/hers, in order to send/receive email, by logging in to the account.

The Examiner submits that Tello disclosed verification of the authenticity of an originator address associated with an outbound message. As the Examiner has cited in the previous office action, Tello disclosed the ISP providing password-protected accounts for users to use their unique email addresses, that provide authorization procedures (such as passwords) to maintain security (Tello, col. 5, lines 55-67).

It would have been within the level of knowledge of one of ordinary skill in the art, that authorization procedures using passwords include logging in to the user's email account and must include verification of the passwords for authorized use of the email account.

Applicant admits, "Barchi further discloses a user name and password required to log in to the system [See Appeal Brief, filed 13 February 2006, page 19, the end of the last paragraph].

If a user is required to log in to an email system to use their unique email address to send email, they are being authenticated/verified by the system to use their unique email address. By requiring the user to log on with username and password, the system is verifying the authenticity of the sender to use his/her unique email address. Therefore, verification of the authenticity of an originator address associated with the outbound message is performed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

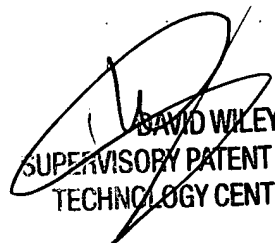
Respectfully submitted,

Jerry Bret Dennison

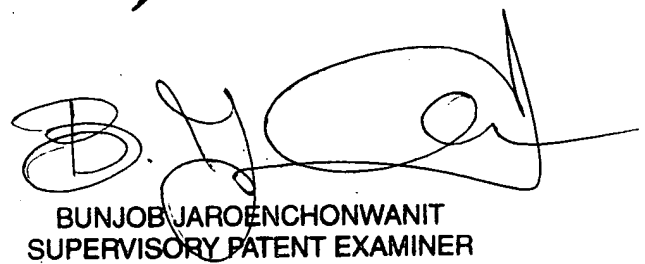
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